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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,268	08/29/2001	Helen Ann Holder	10016648-1	7255

7590 12/14/2001

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EXAMINER

GONZALEZ, JULIO C

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 12/14/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,268

Applicant(s)

HOLDER ET AL.

Examiner

Julio C. Gonzalez

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

- ✓ 1. Figures 1, 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- ✓ 2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 107 in figure 3. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- X 3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the heat generating source disclosed in claim 3, the solar cell disclosed in claim 4, the wind turbine disclosed in claim 5, the flywheel apparatus disclosed in claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- X 5. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant discloses using several means for producing electricity (e.g. solar cell, wind turbine, flywheel), but does not describe how the components producing electricity will be incorporated to the invention or what modifications to the invention have be done since using a flywheel or solar cells are two complete different means for producing electricity and incorporating such devices to an invention involves modification to an invention. Also, how would a heat generating source be incorporated to the invention? How does it function? What is producing electricity, the heat generating source or the retrofittable power supply? The specifications explain the used of cells for generating electricity, but does not provide as to how the components are incorporated. It seems like if the invention is a "black box" with an input (DC voltage) and an output (desk top computer).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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✓ 7. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, what is meant by the housing having a "form factor" equal to a power supply?

Is the housing equal to a conventional power supply? How is it that the retrofittable power supply replaces the power supply device? What if the power supply does not require wires (e.g. a battery, UPS)?

In order to advance prosecution in the merits, the Prior Art will be applied as best understood by the examiner.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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9. Claims 1, 6, 7 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Loh.

Loh discloses a power supply having a housing, a DC power generator, a battery 32, a DC/AC converter 40 and one or more AC connections 70, 72 (see figure 4A).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loh in view of Vaidyanathan.

Loh discloses a power supply having a housing, a DC power generator, a battery 32, a DC/AC converter 40 and one or more AC connections 70, 72 (see figure 4A). However, Loh does not disclose the type of battery.

On the other hand, Vaidyanathan et al discloses for the purpose of delivering high amount of energy and permitting the battery to be hermetically sealed, a rechargeable proton fuel cell.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a power supply as disclosed by Loh and to modify by using proton fuel cell for the purpose of delivering high amount of energy and permitting the battery to be hermetically sealed as disclosed by Vaidyanathan et al.

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12. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loh in view of Hsu et al.

Loh discloses a power supply having a housing, a DC power generator, a battery 32, a DC/AC converter 40 and one or more AC connections 70, 72 (see figure 4A). However, Loh does not disclose using a heat generating source.

On the other hand, Hsu et al discloses for the purpose of increasing the overall power efficiency in a gas turbine and electrochemical converter that a heat generating source in combination with fuel cells is used (see figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a power supply as disclosed by Loh and to modify by using a heat generating source for the purpose of increasing the overall power efficiency in a gas turbine and electrochemical converter as disclosed by Hsu et al.

13. Claims 4, 5, 9, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loh in view of ordinary skill in the art.

Loh discloses a power supply having a housing, a DC power generator, a battery 32, a DC/AC converter 40 and one or more AC connections 70, 72 (see figure 4A).

Loh discloses the claimed invention except for using a wind generator, solar cell or a flywheel. It would have been an obvious matter of design choice to use such sources of energy, since applicant has not disclosed that the using a wind generator, solar cell or flywheel solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with fuel cells.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio C. Gonzalez whose telephone number is (703) 305-1563. The examiner can normally be reached on M-F (8AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jcg

December 11, 2001


